

No. 15,893

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

CEE-BEE CHEMICAL Co., INC., a corporation,

Appellant,

vs.

DELCO CHEMICALS, INC., a corporation,

Appellee.

BRIEF OF APPELLANT IN RESPONSE TO APPELLEE'S BRIEF.

C. G. STRATTON,

LOUIS M. WELSH,

210 West Seventh Street,
Los Angeles 14, California,

Attorneys for Appellant

Cee-Bee Chemical Co., Inc.

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Comes now the above-named appellant and in response to appellee's brief, states as follows:

Appellee Reversed Questions on Appeal.

It is believed that the appellee in its brief should have reversed the two questions which it submits on appeal. It puts the question of validity first, and the question of whether there is a genuine issue of material facts second (pp. 3-4). It is submitted that the first, and the appellant believes the only question to be considered by this Honorable Court is whether there is at least one genuine issue of material fact which precluded the lower court from granting the appellee's Motion for Summary Judgment. This is not an appeal from a judgment after a trial on the merits of the case. If this Honorable Court holds

that there is at least one genuine issue of material fact, then a reversal of the lower court would seem to be in order, and the second question, to wit, *re* the validity of the patent in suit, is not to be considered at this time.

Appellee's Brief Divided Into Two Parts.

Appellee's brief filed herein appears to have been written by two different persons. The first twelve pages are devoted to sweeping generalities which are rather unrealistic, ignoring facts where it seems convenient to do so, and failing to point out specifically the bases for the pages of legal conclusions. The last twenty-one pages appear to be more specific to the present case. The appellant will endeavor to point out discrepancies in both the general and the specific parts of appellee's brief.

Appellee Argues There Are No Genuine Issues of Material Fact.

The appellee "represents" that there is "no genuine issue as to any material fact necessary to the consideration and determination of the question of the validity" of the patent in suit (pp. 4 and 12), "no genuine issues of material fact being involved" (p. 6), "controlling facts are uncontroverted" (p. 9), "controlling facts in this case are . . . unchallenged" (p. 9), "the evidence . . . is unchallenged and uncontroverted" (p. 10), "uncontroverted facts" (p. 11), the claims "define nothing more than what was already clearly described in prior patents" (p. 13), "the controlling facts are uncontroverted" (p. 24), "Appellant has no quarrel actually with

the evidence" (p. 27), "undisputed facts" (p. 28), "no facts in dispute" (p. 28), "there is here no genuine issue of material fact necessary to deciding the question of law involved, i. e., validity of the patent in suit" (p. 30), "there is no issue, or the facts involved are not material, or the alleged issue is not 'genuine' " (p. 30), "no issue of fact, genuine or otherwise, as to . . . the contents of the various prior art patents" (pp. 31-32), and, on the very last page of the brief, "the case boils down to a pure question of law without any genuine issues of material fact" (p. 33).

The contention of appellee that there is no genuine issue of material fact is probably the most frequently reiterated phrase in the appellee's entire brief. Because of such repetition, appellee must feel that this question is of prime importance, and that if the Appellant can show even one genuine issue of material fact, then the judgment of the lower court should be reversed. It is believed that it can be shown from appellee's own brief that there is more than one genuine issue of material fact in this case, as will now be considered.

MATERIAL ISSUE NO. 1:

Does the Patent in Suit Cover a "Soapy" Solution?

The appellant in its original brief in this case pointed out that the second step of claims 2 and 3 of the patent in suit covers the applying of "a substantially less volatile, water-rinsable, solvent-miscible spray to the solvent on the sealant." This is not denied by appellee, but appellee

in its brief argues that the soap of the prior Foster patent is the same thing. The following are the diametrically opposite contentions of the parties as to this second step:

Appellant's Contentions.

1. This "solvent-miscible" material is not a "soapy" solution.

2. A soapy solution would wash away the solvent and leave the sealant as it originally was—unremoved.

3. The use in the second step, of a soapy solution, would defeat the patented process, render it inoperative, and produce just the opposite results from those desired [Tr. pp. 96-97].

4. The use of the soapy solution of the prior patent to Foster, No. 1,141,243. would render the patent in suit inoperative.

Appellee's Contentions.

1. This "solvent-miscible" material is a "soapy" solution.

2. The patent in suit uses a soapy solution.

3. The second step of the patent in suit covers a soapy solution and a soapy solution does not render the patented process inoperative.

4. The use of the soapy solution of said Foster patent is the same as the second step of the patent in suit.

The importance of this point to appellee may be seen by the fact that it repeats "soap" or "soapy" approximately eleven times in its thirty-three page brief.

The following are the opposed positions taken by the parties on this issue of fact:

Appellant's Evidence.

1. "Soap of a soapy solution is not solvent-miscible . . . and would wash away the solvent and definitely cause the sealant to re-set as a hardened rubber compound, so soap or a soapy solution would be inoperative and produce just the opposite results from those desired."—Whitcomb affidavit [Tr. pp. 96-97]. "None of the prior patents" teaches the use of an emulsifier that is "'solvent-miscible.'"—Seller's affidavit [Tr. p. 107].

2. The second step found in the claims (*e. g.*, claims 2 and 3) "is not found in any of the prior art." (Appellant's Br. p. 19.)

Appellee's Position.

1. "The meaning is the same" whether it is "soap", "soapy" or "solvent-miscible" (Appellee's Br. p. 26).

2. "Every Element of Every Claim is Found in Analogous Prior Patents Not Cited by the Examiner" (heading in Appellee's Br. p. 19).

This is not "a mere quibble on words," as stated by appellee (p. 21), for if appellant's testimony and contentions are correct, the second step of the patented process is novel, produces an entirely new result over anything in

the prior art, and the question of its novelty is an issue of a material fact that should never have been decided on a Motion for Summary Judgment.

This appears to be a genuine issue of material fact that should not have been decided by the lower court on a Motion for Summary Judgment. The lower court is believed to have erred in its Conclusion of Law No. 3 [Tr. pp. 152-153] when it said that there is “no substantial dispute of fact as to . . . the prior art patents . . . and extrinsic evidence not being required for the purposes of explanation.” Both of these statements seem to be wrong, for there is the sharp dispute mentioned above concerning the prior Foster patent, to wit, whether it covers use of a “solvent-miscible” material. This is a material issue, because if the appellant’s contention is correct, then no prior patent shows the use of a “solvent-miscible” rinse (second step) between the applying of the solvent and the final wash water. The lower court is thought to have committed reversible error by stating there was “no substantial dispute” on this issue of fact.

MATERIAL ISSUE NO. 2:

Are a “Weir” and a “Screen” the Same for the Present Purposes?

Another genuine issue of material fact raised by appellee’s brief is whether a “weir” is the same thing as a “screen.” The appellee admittedly did not understand the differences between a weir and a screen, as pointed out in appellant’s original brief. The appellee terms same

“almost incomprehensible” (p. 25). The contentions of the parties side-by-side would apparently look like this:

Appellant's Contentions.

1. In Butterworth 2,018,757, Figs. 2 and 3 (these are different views of the same thing) show, and the specification describes, a dam 38 and a settling basin 35 behind the dam 38. Material only flows over the dam permitting “scale or other solid material” to sink to the bottom in the basin 35 behind the dam so it will not spill over into the line 36. This dam 38 is called a “weir.” — Seller’s affidavit, pp. 103-104.

2. A weir will not operate, nor accomplish the same result, as a screen in either the patent in suit or in appellee’s accused structure, because (a) the loosened, sponge-like sealant is almost the same specific gravity as the liquid solvent and practically floats, and (b) this sealant, by reason of the rapid flow of the solvent, would be washed over the top of the weir or dam with the liquid solvent [Tr. pp. 94-95].

Appellee's Contentions.

1. In Fig. 2 of Butterworth 2,018,757, the weir is not in the nature of a dam and material does not flow over the top of the weir. Appellant’s contention is “contrary” to this Butterworth specification (Appellee’s Br. p. 20). The solvent passes “through” the weir (p. 19, *supra*).

2. “A weir and a screen are equivalents—they constitute substantially the same instrumentalities operating in substantially the same way to accomplish substantially the same result, *i. e.*, straining out the chunks of material dislodged by the sprays.” (Appellee’s Br. p. 26.)

The dictionary definition of a weir is, "A dam in a river to stop and raise the water", and "A device for determining the quantity of water flowing over it" (Webster's New International Dictionary, 2d Edition).

The more strenuously the appellee argues that Foster's soap solution is the same as a solvent-miscible material, and that the weir of the prior Butterworth patent accomplishes the same result as the patented screen, the more clearly it emerges that here we have two strenuously disputed genuine issues of material fact; that therefore, extrinsic evidence is necessary to understand these two prior patents, and that the lower court should never have "short circuited" these strong issues of fact by granting a Motion for Summary Judgment.

MATERIAL ISSUE NO. 3:

Are Prior Patents Relied on by Appellee Closer Than Prior Patents Cited by the Examiner?

A third issue raised by appellee's brief is whether the prior art cited by the Examiner was as close as the prior patents not cited by him but cited by appellee in this case. This issue of fact faces up something like this:

Appellant's Testimony.

The patents not cited by Examiner and relied upon by appellee "are no more relevant or persuasive of non-invention" in the patent suit, than the "patents cited by the Examiner" [Seller's affidavit, Tr. p. 100].

Appellee's Contra.

The "Examiner allowed Whitcomb application because he did not have the most pertinent prior art before him" (heading in Appellee's Br. p. 17).

Here, again, it is believed that the lower court should not have decided a question of material fact on a Motion for Summary Judgment. Nevertheless, the District Court decided that “the patents not cited by the Examiner are decidedly more pertinent” [Tr. p. 139], and this was a vital basis for the Court’s entire decision.

MATERIAL ISSUE NO. 4:

Whether Patented Process Produces Obvious Result?

The fourth issue raised by appellee’s brief is that the method of the patent in suit produces an “obvious and expected result” (p. 16). The appellee is overlooking the testimony that “stringers” in airplane wings were never cleaned out before the patented process came into use [Tr. p. 93]. The patented process cleaned them out, so thereafter the United States Air Force required that stringers be cleaned out! The appellee is overlooking the unexpected result that fumes and fine vapors, rather than direct spray from the nozzles, reached solvent where liquid solvent would not go [Tr. p. 204]. The appellee has also overlooked that the impingement of the liquid solvent upon the interior of the tank, in the patented process, generated heat *at the point* where it was needed for further volatilization of the volatile solvent [Tr. p. 92]. This was unexpected. None of these features was obvious since they had to be discovered after the patented process was put in use.

Outstanding proof that the patented process was not “obvious to one skilled in the art at the time the invention was made” (Appellee’s Br. p. 13) is that the record in this case shows that three trained mechanics and one General of the United States Air Force were surprised when the process of the patent in suit operated success-

fully! Nothing could be clearer than that it was not obvious to one skilled in the art, and that it produced an unexpected result. In any event, here we have a genuine issue of material fact as to whether the patented process was an obvious method, which should not have been finally determined by the lower court as not producing any unexpected result [Tr. p. 152].

The following quotation from a recent case seems apt at this point:

“. . . Those who wish to take advantage of it and deprive the inventor of the fruits of his invention unite to vie with each other in pointing out how simple it all was and how little worthwhile.”

—*The Guiberson Corporation v. Equipment Engineers Inc.*, 116 U. S. P. Q. 425, 428 (C. A. 5, Feb. 25, 1958).

Appellee's Principal Authority.

Bergman v. Aluminum Lock Shingle, 116 U. S. P. Q. 32 (C. A. 9), was cited four times in appellee's brief, which is more than any other case. That case, however, was not based on a Motion for Summary Judgment. A full trial was held in that case, and this Honorable Court was called upon to decide whether it was a question of fact or a question of law as to whether the extremely simple slot in a shingle constituted an invention. It is not believed that this Honorable Court intended that that case should be interpreted to mean that all questions pertaining to the validity of a patent are only questions of law, as the appellee seems to interpret this case.

Circuit Judge Pope, in his concurring opinion, brought out that this case “is not to say that the decision in a patent case may not turn upon a question of fact.”

He quoted with approval *Walker on Patents*, Deller's Edition, page 115, that, "The nature of prior art . . . must always be questions of prior art."

Circuit Judge Pope referred to earlier decisions of this Honorable Court in which the question of validity was considered a question of fact, and stated that if he thought the *Bergman* case, *supra*, was in true conflict therewith, he would "call for a hearing by the whole court sitting in banc in order to resolve that conflict."

He concluded that the question of validity in the *Bergman* case did turn on a question of law, but that the question of validity of an invention may "turn on" a question of fact. It is believed that that is a statement that can be subscribed to by every member of this Honorable Court. It is submitted that the present case is one that "turns on" several questions of fact, which are dealt with elsewhere herein and in appellant's original brief (viz., "the nature of the prior art"), and that the *Bergman* case is not authority that all disputed issues of fact as to the nature of the prior art may be decided upon a Motion for Summary Judgment.

"Hand" Process.

A rather far-fetched bit of unreality has been injected into appellee's brief under the heading "A 'Hand' Process" (p. 15). Appellee is apparently endeavoring to get this Court of Appeals to consider some sort of evidence that was not before the lower court and is not properly part of the record before this Court.

No attempt has been made to show that this "Hand" Process ever took place, or that it was even thought of before the application for the patent in suit. Furthermore,

it is only wishful thinking and could not take place. It takes 40 hours of *continuous* circulation of solvent to loosen sealant in an integral aircraft tank (see Whitcomb Affidavit of July 7, 1953, in file wrapper). Claim 1 calls for carrying on the patented process in a “sealed” tank. How is the hypothetical user with a milk bucket and a “Flit” gun going to be sealed inside the aircraft tank for 40 hours, refill his milk bucket outside the tank every time it is empty, and yet perform 40 hours of continuous spraying within the highly toxic fumes inside the tank? How will his “Flit” gun spray opposite sides of bulkheads inside the fuel tank, as covered in claim 4? Imagine trying to de-seal a military aircraft in time of war by this totally impractical method. The war would be over before that aircraft would ever fly again.

The author of this science fiction is suggesting an impractical *batch* process for “a continuous closed-circuit process” (claim 4). If the appellee followed the milk bucket—“Flit” gun-batch-hand process which appellee’s brief describes, it would go out of this business upon its first job!

Lower Court’s Opinion as to What Is “Dispositive”.

Of course, no one disputes that if a court has before it all the facts necessary to enable it to determine a question of invention or anticipation, and if the facts are complete and are not in dispute, it can pass upon that issue on a Motion for Summary Judgment. Here, however, not only are the facts believed to be in sharp dispute, but there are also additional facts which will be produced upon a trial that will throw considerable light upon the issues, so it is thought that the present matter cannot properly be resolved without a trial.

A number of factual issues which were presented to the lower court were side-stepped by it with the Court's statement that "a single issue . . . is dispositive of the case" [Tr. p. 144]. The appellee commented on an issue of fact with regard to documentary evidence and said that it is "not here important because it did not furnish a basis for the decision of the Lower Court" (p. 24). This situation obtains as to not one document, but to Exhibits G, H, K, L and M.

The appellee did not cite any authority to support the lower court's position that it could pick out what it decided was a dispositive basis for its decision and disregard all other matters. The appellee did not even mention that this Honorable Court has already held in *Gillespie v. Norris*, 231 F. 2d 881, 883-884 (C. A. 9, 1956) (quoted in appellant's original brief), that this course should not be followed. Suppose the lower court is in error as to what is dispositive, as he is believed to be in this case? This would lead to multiple, piecemeal appeals in a single case. That is the very criticism of this Honorable Court in the *Gillespie v. Norris* case, *supra*. To discourage future such "dispositive" decisions, it is believed that this Honorable Court should reverse the present case alone on the ground that other genuine issues of material facts were by-passed in favor of a single issue which was thought to be dispositive. This case is believed an excellent example of the possibility of piecemeal appeals.

“Stardust”.

The appellee makes the appeal that it is just “stardust” in our eyes to think that the patented process is anything more than the prior art.

The saving of millions of dollars over the best process used previously to remove sealant from aircraft tanks is not “stardust”. The experts had all the tank car and ship hull washing patents cited by the appellee. If these old methods could be used for the present purpose, why did the entire industry use a hand-scraping method and then the fill-soak-and-drain method? If it were obvious that the methods of these prior patents would do this work, why was all the money spent on said old methods for removal of sealant from aircraft tanks? Even when told of the patented process, the experts did not believe it would work! That is the finest of proof that it was not obvious.

The patented process is not “stardust” when it saves millions of dollars.

Since the appellant’s brief was filed, there has been published in the Los Angeles Daily Journal, to wit, on June 20, 1958, an article based on Senate Report No. 1430, entitled, “Patents, Trademarks and Copyrights”, in which report the Chairman of the Subcommittee investigating those subjects, Senator Joseph C. O’Mahoney of Wyoming, is reported as stating:

“The inventiveness, ingenuity, and technical skills of its citizens constitute the sinews of this nation’s economic and military strength. They comprise our most important safeguard of victory in the technological race with foreign powers. They ensure max-

imum scientific progress. One of the stimuli to inventiveness and technological advancement traditionally has been the patent system."

It is believed that those who produce new inventions which are "the sinews of this nation's . . . military strength" should be rewarded. Research on new ideas is expensive, and if protection is not given for new inventions, why should any person or corporation spend money in research for new ideas? It would be far cheaper to wait until a competitor has a successful invention and then just copy it. The patent laws were designed by our forefathers as a means of encouraging people to disclose their new ideas. Without a reward for doing so, inventors will cease to disclose their new ideas and they will be lost to the general public.

Conclusion.

It is submitted that for the several reasons stated, the judgment of the lower court granting the present Motion for Summary Judgment should be reversed.

Respectfully submitted,

C. G. STRATTON,

LOUIS M. WELSH,

Attorneys for Appellant Cee-Bee Chemical Co., Inc.

